

Appl. No. 09/991,529
Atty Docket No. 1205-009/JRD
Amendment Dated Oct 3, 2005
Reply to Office Action of Sept. 8, 2004

Corrected pursuant to Notice of Non-Compliant Amendment dated June 1, 2005

REMARKS

A non-final Office Action, dated September 8, 2004, rejects pending claims 1-20. A notice of non-compliant amendment dated June 1, 2005 objected to the status identifiers used in with the claims submitted in an amendment submitted on March 8, 2005. Claims 1, 9, 10 and 18 have been amended herein. Reconsideration is respectfully requested in of the following remarks.

35 USC § 103

Applicants respectfully traverse the examiner's rejection of claims 1-20 as somehow being rendered obvious by the references of record. The references of record are either missing essential elements, or they are missing a teaching or suggestion to combine them as currently claimed.

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so" [MPEP § 2143.01]. Applicants traverse the examiner's rejections of these claims on at least the following grounds:

1. There is no teaching to activate a tag-mounted worker signaling device in a pharmacy in response to predetermined criteria detected by a computer system.

Applicants maintain that the references relied on by the examiner are not sufficiently enabled and/or they do not have the requisite filing dates to be considered "prior art" against the present application. However, even if these references were enabled and timely, they still do not teach or suggest the present combination of elements as currently claimed.

Published U.S. Patent Publication No. 2004/0036623 to Chung ("the Chung Reference") discloses displaying on a monitor and/or printing from a printer a warning in response to a detected discrepancy in dispensing medications from a "master" container of medicine to a unit/dose container of medicine. (See Paragraphs 132-136 and FIGS. 2 & 6 of Chung). Published U.S. Patent Publication No. 2002/0180588 to Erickson et al. ("the Erickson Reference") teaches illuminating an LED on an RFID tag to facilitate locating the tag. Neither reference alone or in combination teach or suggest activating a warning device on the tag itself in response to predetermined criteria detected by a computer system that is in communication with that warning

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device. If anything, the Chung Reference teaches away from such a structure by forcing a pharmacy worker to check a monitor and/or check any output from a printer to verify if an error was detected.

In contrast, the presently claimed invention activates a warning structure on the tag itself, right where the pharmacy worker is looking when working with the prescription order. Such a system improves worker efficiency and reduces filling and dispensing errors in the pharmacy.

2. There is no teaching to provide a timing element with the Chung Reference.

Similarly, there is no teaching to combine any timing elements present in U.S. Patent Publication No. 2001/0017817 to De La Heurga ("The De La Heurga Reference") with The Chung Reference. As previously noted, the Chung reference is limited to warning a worker if a comparison error is detected. Accordingly, these references cannot alone or in combination render claim 18-20 obvious.

3. Applicants traverse the examiner's reliance on "common knowledge."

"It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP Sec. 2144.03(A). Applicants respectfully traverse the examiner's rejections of claims 2, 5-17 and 20 based on grounds that essential elements of these claims are "notoriously old and well know in the art." While some of the cited structures may have been known individually, their incorporation into a pharmacy system and/or on a tag as currently claimed in the present set of claims was not obvious at the time of this invention. If anything, the Chung Reference teaches away from incorporating such structures into a pharmacy by disclosing displaying any discrepancies on a monitor or a printer, well away from the prescription order at issue.

Should the examiner elect to continue to maintain his rejections based on these grounds, pursuant to MPEP Sec. 2144.03(C), applicants respectfully request documentary evidence to support the examiner's position on this issue.

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In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

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